

### REMARKS

Applicant respectfully requests consideration of the subject application. Amendments to claims 1, 31, 72 and 74 are supported in the specification as filed, for example at paragraphs 34 and 44, and figures 3-4 of US PGPUB 2002/0169669, the publication of the instant application. Various claims have been amended for clarity and to correct minor typographical errors. Claims 14, 25, 45-46, 48-51, 54-56, 58, 60 and 78-82 have been cancelled to expedite the prosecution of the present application. No new matter has been added by any of the present amendments.

### 35 U.S.C. § 103 Rejections

Claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72 and 74 are patentable over Thomas, (U.S. Patent No.: 6,128,663, hereinafter "Thomas") in view of the Official Notice.

Claim 1, as amended, recites a method including, among other things, the following features:

- determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement and directs a user's attention to the banner advertisement
- and
- serving said tailored message for display to said user on said World Wide Web page separate from said banner advertisement, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.

At least these features of claim 1 are not taught or suggested in Thomas.



In contrast, the above-mentioned features of claim 1 are not present in Thomas, for example in figure 11 (annotated below):

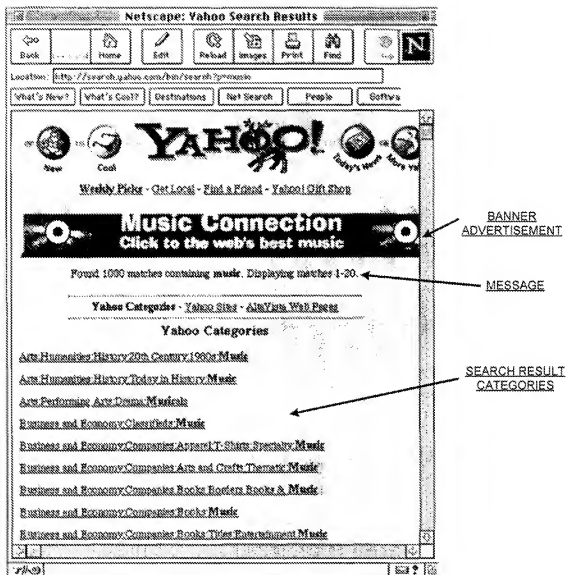


FIG. 11

While Thomas may display a banner advertisement and a message, the message of Thomas directs the user's attention to search result categories, and not to the banner

advertisement, as recited in claim 1. Therefore, claim 1 and its dependent claims are patentable over Thomas.

In addition, it is noted that the Office Action interprets the banner advertisement of Thomas as the tailored message of former claim 1. (Office Action, page 6) This interpretation is no longer possible in amended claim 1, which recites a banner advertisement and a tailored message separate from the banner advertisement. Clearly, if the banner advertisement of Thomas were interpreted as a tailored message, it would not also be separate from the banner advertisement of Thomas.

The following teachings of Thomas are further noted to provide contrast with the present invention:

- Thus, there is a need for improved banner advertising on the Internet whereby the advertising banners displayed or other portions of a web page are targeted and/or customized to a user so that the web page is more effective. (Thomas at col. 1, ll. 60-63)
- For example, the requested page often includes an advertising banner, and according to the invention, the particular advertising banner that is chosen to be transmitted with the requested page is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc. (Thomas at col. 4, ll. 58-65)
- Also, the determining of the file can select from available variants for the requested page based on the demographic information, and the customizing can modify a file for the requested page such that its content is more suitable to the requestor's demographic information or otherwise personalized to the requester. After the file is determined or customized, the file is forwarded 228 to the requestor. (Thomas at col. 7, ll. 10-17)
- There are many examples of customization, including adding a greeting, selecting an appropriate variant page, selecting an appropriate advertisement to display. (Thomas at col. 8, ll. 64-66)

In other words, Thomas may contemplate inserting a greeting into the webpage depicted in figure 11. Even if so, a greeting (absent further details) does not specifically provide a message separate from a banner advertisement that is thematically related to said banner advertisement and directs a user's attention to the banner advertisement, as recited in claim 1.

Thomas may also contemplate replacing the banner advertisement of figure 11 with a banner advertisement determined in accordance with a demographic identifier of a user. Even if so, a modified banner advertisement does not specifically provide a message separate from a banner advertisement that is thematically related to said banner advertisement and directs a user's attention to the banner advertisement, as recited in claim 1.

Lastly, Thomas may contemplate selecting an appropriate variant of the webpage displayed in figure 11 (or portion thereof). Even if so, such vague teachings do not specifically provide a message separate from a banner advertisement that is thematically related to said banner advertisement and directs a user's attention to the banner advertisement, as recited in claim 1. For at least the foregoing reasons, claim 1 and its dependent claims are additionally patentable over Thomas.

It is noted that the Examiner has taken Official Notice of the following:

1. That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like;
2. That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad;

3. That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed;
4. That changing display attribute within a message such as changing display color or image will bring the user's attention to the message; and
5. That it is old and well-known to serve default messages when targeting criteria hasn't been met. For example, default messages for or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Such Official Notice fails to cure the above-mentioned deficiencies of Thomas. For example, even if Official Notice #2 were true, it does not specifically address banner advertisements. Moreover, the Office Action does not reconcile Official Notice #2 with the above-referenced teachings of Thomas in which a message placed in proximity of a banner advertisement directs the user's attention to search result categories and away from the banner advertisement.

Therefore, claim 1 remains patentable over Thomas, even in view of the Official Notice. Claims 31, 72 and 74 recite features similar to those recited in claim 1. Therefore, claim 31 and its dependent claims, and claims 72 and 74 are likewise patentable over Thomas in view of the Official Notice. Accordingly, it is respectfully requested that the rejection to claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72 and 74 under 35 U.S.C. §103 be removed.

Applicant respectfully submits that the present application is in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,  
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